



**UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/304,859	05/04/99	BERD	D 1225/1E251-U

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HM22/0607

EXAMINER

HUNT, J

ART UNIT

PAPER NUMBER

1642

DATE MAILED:

06/07/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/304,859

Applicant(s)

Berd, David

Examiner
Jennifer Nichols, Nee Hunt

Group Art Unit
1642



☒ Responsive to communication(s) filed on Feb 7, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-10 and 12-24 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-10 and 12-24 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 6

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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Response to Amendment

1. Claims 1-10 and 12-24 are pending.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior office action.

Sequence Compliance

3. The sequence listing and CRF for this case have been received and entered.

Oath/Declaration

4. The objection to the declaration is withdrawn in light of applicant's submission of a corrected declaration.

Specification

5. The objection to the specification because it lacks a brief description of the figures is maintained. Applicant has made no amendments or arguments to rebut this objection.

Claim Objection

6. Claim 1 is improper because it ends with a comma instead of a period.

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Claim Rejections Withdrawn

7. The rejection of claims 1-23 under 35 U.S.C. 112 2nd paragraph are withdrawn in light of the amendments thereto.

Claim Rejections Maintained

8. The rejection of claims 1-23 under the judicially created doctrine of double patenting is maintained, and newly applied to claim 24 for reasons of record and as detailed below.

The rejection of claims 1-23 under 35 U.S.C. 103(a) is maintained, and newly applied to claim 24 for reasons of record and as detailed below.

Applicant has argued both rejections together, and so the following response applies to both rejections.

Applicant argues that there is no motivation to combine the teachings relied upon for the rejection. Applicant maintains that Elliot is not properly combined with Berd and in fact teaches away from Berd, because Elliot uses a different type of tumor vaccine than Berd and therefore those protocols are not properly compared. This argument is not found to be persuasive.

Although the types of tumor vaccines taught in the references are not the same, the Elliot reference is drawn only to the limitation of weekly booster injections and is used to demonstrate that weekly injections are art conventional. Thus that the vaccines are exactly the same is not critical to the teachings of Elliot. Eliot is applied to provide evidence that weekly vaccine

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administration is art standard. Applicant further argues that there would be no motivation to alter the protocol of Berd because the methods in Berd were effective, however instituting art known modifications, including changing adjuvants, dosages, or administration protocols would be obvious variations of the known methods and would be desirable for the purpose of optimization of vaccine effectiveness, and thus the rejection of claims 1-10 and 12-23 under the judicially created doctrine of double patenting, and under 35 U.S.C. 103(a) is maintained.

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer Nichols, whose telephone number is (703) 308-7548. The examiner can normally be reached Monday through Thursday 6:30am to 5:00pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa can be reached at (703) 308-3995. The fax number for the group is (703) 305-3014 or (703) 308-4242.

Communications via internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [anthony.caputa@uspto.gov].

All internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists the possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the group receptionist, whose telephone number is (703) 308-0196.

Jennifer Nichols, Nee Hunt


YVONNE EYLER, PH.D
PRIMARY EXAMINER

June 5, 2000